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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054171
Party	Defendant VGO Communications, Inc.
Correspondence Address	MICHAEL J BEVILACQUA WILMER CUTLER ET AL 60 STATE ST BOSTON, MA 02109 UNITED STATES Barbara.Barakat@wilmerhale.com, angela.dyer@wilmerhale.com, Michael.Bevilaqua@wilmerhale.com
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Date	11/25/2014
Attachments	VGO Response to Motion to Compel.PDF(548895 bytes)

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Valeritas, Inc.,)	
)	
Petitioner)	
)	
v.)	Cancellation No. 92054171
)	
VGo Communications, Inc.,)	
)	
Registrant)	
)	

INTRODUCTION

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reopen discovery and reset the schedule of this proceeding, and to do so would reward the Petitioner's delay in responding to discovery.

ARGUMENT

PETITIONER HAS HAD AMPLE OPPORTUNITY TO CONDUCT ITS

DISCOVERY

Petitioner has had ample opportunity to conduct its discovery. Discovery in this proceeding opened September 6, 2011 and was first set to close on March 4, 2012. Petitioner first requested that Respondent consent to extend discovery in January 2012. Respondent consented to a 90 day extension of all dates. Petitioner requested additional extensions in May 2012, August 2012, September 2012, November 2012, January 2013, March 2013, May 2013, June 2013, August 2013, September 2013, October 2013, November 2013, December 2013, January 2014, February 2014 and March 2014. In each case, Respondent agreed to the extensions of time requested by the Petitioner. On May 12, 2014, the Board issued a Notice of Suspension until August 9, 2014 in the proceeding. Discovery finally closed on September 10, 2014. Petitioner has had more than 3 years to conduct its discovery and take any discovery depositions that it needed.

Petitioner also alleges that discovery should be reopened so that it can conduct depositions of Respondent's employees, Ned Semonite and Bern Terry. Respondent had made these witnesses available for deposition, but Petitioner chose not to conduct those depositions. Nonetheless, should it decide to depose those men, Petitioner can do so during the testimony period.

PETITIONER HAS NOT ACTED IN GOOD FAITH IN PRESENTING THIS

MOTION

Additionally, Petitioner has not acted in good faith in presenting its reasoning for this motion and has mischaracterized the facts. For example, the Petitioner alleges that its letter of August 14, 2014 was not responded to in a timely manner. This letter was sent by FedEx addressed to Mr. Bevilacqua and Ms. Barakat and was received in Respondent's counsel's docketing office on August 18, 2014. Both counsel left for vacation on August 14, 2014, which fact counsel for Petitioner knew because she transmitted an email version to Mr. Bevilacqua and Ms. Barakat on August 18, 2014. When she received the "out of office" messages, counsel for Petitioner then forwarded her email to Mr. Hobgood, who was also on vacation. Respondent did not "confirm receipt on August 18, 2014," as stated in the Motion to Compel, but on August 20, 2014, Mr. Bevilacqua responded to counsel for Petitioner to state that all of the counsel for Respondent for this matter were on vacation and would look into the matters raised in the letter when they returned the next week. On August 27, 2014, counsel for Respondent responded to counsel for the Petitioner. In most cases, Respondent indicated that it had answered the particular discovery request for which a question was raised, and the Petitioner was referred to the response to a particular interrogatory or documents produced. In some cases, counsel for Respondent indicated that it was checking with the Respondent. Respondent did serve amended responses to the Interrogatories and additional documentation on September 10, 2014.

In the meantime, the Petitioner has not been forthright in its own production. At various times during these proceedings, the parties have attempted to work with each other to fully comply with discovery production. Respondent served its first Set of Interrogatories and

Requests for Production of Documents on Petitioner on October 5, 2011. Petitioner responded on November 23, 2011. Respondent served its second Set of Interrogatories and Requests for Production of Documents on Petitioner on December 12, 2011. Petitioner responded on January 17, 2012. Respondent served its third Set of Interrogatories on Petitioner on March 1, 2012. Petitioner responded on April 5, 2012. The Petitioner did not, however, produce its first batch of documents until May 8, 2012.

Respondent sent a letter by email and first class mail outlining the deficiencies in Petitioner's production on September 6, 2013. By email dated September 9, 2013, Petitioner made a commitment to produce documents on a "rolling basis." On September 13, 2013, Petitioner produced additional documents.

Respondent sent an email again to Petitioner on August 27, 2014, listing the deficiencies in Petitioner's production. No response was received to this email before Petitioner served a Motion to Compel and Extend Discovery, one day before the discovery period was set to close. The Board denied the motion.

A full 19 days after receipt of Respondent's email listing Petitioner's discovery deficiencies, on September 15, 2014, counsel for Petitioner confirmed receipt of the August 27, 2014 email and stated that they were gathering information. On October 15, 2014, counsel for Respondent requested a status update on the responses, and on October 27, 2014, counsel for Petitioner stated that a substantive response would issue "shortly." On Friday October 31, 2014, counsel for Petitioner stated that "we expect to begin producing documents by early next week. We suspect it may be on a short rolling basis throughout the week." On November 5, 2014, Petitioner produced additional documents responsive to one request. Finally, on November 7,

2014, Petitioner produced supplemental responses to Respondent's interrogatories and requests for production of documents and additional documents. On November 7, 2014, Petitioner filed its Motion to Compel and on November 8, 2014, a Motion for Summary Judgment.

As stated above, Respondent provided its additional responsive documents on November 25, 2014. This date is only approximately 2 weeks later than the date on which Petitioner provided its most recent responsive documents. Petitioner has not acted in good faith, and seeks this extension for no other reason but to put undue pressure on the Respondent and to have another shot at conducting discovery because it has not found information and/or documents to support its theory in the cancellation, information or documents that do not exist. Petitioner should not be rewarded by reopening discovery when it was not fully compliant in its discovery responses until two weeks ago, long after the discovery period was closed.

RESPONDENT HAS COMPLIED WITH ITS DISCOVERY OBLIGATIONS.

On November 7, 2014, Petitioner filed this motion asking the Board to "compel Respondent to comply with its discovery obligations, including, without limitation, producing all electronic mail which is responsive to any or all of Petitioner's multiple request for production of documents." Respondent has responded to each Interrogatory, Request for Production of Documents and Request for Admission made by Petitioner. When the Petitioner has alleged deficiencies in the Respondent's production, Respondent has responded to the allegations of deficiency in a timely manner to resolve any dispute and has produced over 1700 documents.

As to the specific deficiencies raised in the Motion to Compel:

Respondent is not in possession of a copy of the YouTube video of an interview given by Mr. Ryden on June 15, 2013 entitled, "Tom Ryden, VGo Cofounder & COO Talks about Robotic Telepresence and IBM Watson is Big Data" hosted by Jim Collison. Despite the fact that Respondent could not produce this video, Petitioner has access to the video through YouTube and is not disadvantaged in any way when Respondent could not produce it.

Respondent's response to Interrogatory No. 15 is not deficient. VCI stated in its response that it has no relationship with companies in the field of treating, evaluating and/or counseling patients with diabetes, including but not limited to PositiveID Corporation. It did not address only "ongoing" business relationships in making this response. VCI maintains that it did not and does not have a business relationship with PositiveID Corporation or any other company in the field of treating, evaluating and/or counseling patients with diabetes.

Respondent's response to Interrogatory No. 16 is not deficient. VCI stated in its response that "PositiveID invited VCI to do a demonstration at the American Telemedicine Conference at PositiveID's booth at that conference but not in conjunction with PositiveID's communication device for diabetes management. For the one-time demonstration, VCI drove its robot from its booth to their [PositiveID Corporation] booth at the tradeshow. When VCI was at the PositiveID Corporation booth, VCI personnel talked with PositiveID Corporation personnel. VCI did not integrate PositiveID Corporation equipment with VCI equipment or do anything with or in conjunction with PositiveID Corporation equipment." The documents, and the article found at Respondent's website and produced to Petitioner were generated by PositiveID Corporation, which characterized this interaction as a "joint demonstration" for its own purposes.

As to the objections to the responses to the Requests for Production of Documents, Respondent submits the following:

Request 17: Seeks production and things concerning any advertisements placed in any magazine or other publication in any format, whether print, online or in any other format;

Respondent reiterates that it has long ago produced representative advertisements. There are no other documents of which Respondent is aware.

Request 18: Seeks production of documents and things concerning any news or feature stories about VCI and/or products sold under VCI's mark that have appeared in any magazine or any publication in any format, whether print, online or in any other format.

Respondent reiterates that it has produced representative responsive news or feature stories and advertisements. All responsive documents have long ago been produced except to the extent that those sought are duplicative. In the most recent investigation, Respondent has provided recent news articles, which were produced to Petitioner with its letter dated November 25, 2014.

Respondent states again that it has produced a printed copy of the Sports Illustrated article. See, VGO000684-694.

Petitioner has asked for any articles or press releases concerning its partnership with PositiveID Corporation. Respondent states again that there are no such documents, since it has never had and does not have a partnership with that company. Respondent has produced the news article that was contained on its website regarding the demonstration with PositiveID Corporation, as shown at VGO1320-1324.

Request 20: Seeks production of documents and things concerning VCI's marketing plans for VCI's mark.

Respondent has provided documents responsive to this request. . Specifically, at VGO 001179-001201. There are no other documents of which Respondent is presently aware.

Request 22: Seeks production of documents and things concerning VCI's competitors in the marketplace.

Respondent has provided such documents in its possession or control. Specifically, see VGO 000664-670. In its most recent investigation, Respondent found additional documents, which have been produced to the Petitioner with its letter dated November 25, 2014. There are no other documents of which the Respondent is presently aware.

Request 29: Seeks production of documents and things concerning contracts or agreements with affiliates, agents, licensees, distributors, dealers, manufacturers' representatives, doctors, wholesalers, and/or retailers through whom VCI markets and sells its goods and services under VCI's Mark.

Respondent has complied with this request. In response to Interrogatory No. 4, Respondent stated that it provides its products to companies within the enterprise, education and healthcare markets directly, or through value added resellers. In its most recent investigation, Respondent found additional documents, which have been produced to the Petitioner with its letter dated November 25, 2014. Respondent has conducted an exhaustive search and has been unable to locate a copy of two reseller agreements, the agreements with RoData and IVCI. If the Respondent does locate copies of either of those agreements, they will be forwarded to the Petitioner immediately. It should be noted, however that the agreements will be substantially

similar to the other reseller agreements already provided. There are no other documents of which Respondent is presently aware.

Request 37: Seeks production of documents and things identifying each and every employee and/or agent of VCI charged with responsibility for VCI's Mark and/or describing any such employee's or agent's duties with respect to VCI's Mark.

In its most recent investigation, Respondent found additional documents responsive to this Request, which have been produced to the Petitioner with its letter dated November 25, 2014. There are no other documents of which Respondent is presently aware.

**RESPONDENT'S RESPONSES TO THE REQUEST FOR ADMISSION ARE
SUFFICIENT**

Request for Admission 24: Admit VCI collaborated with a company named PositiveID Corporation.

Respondent continues to object to the term "collaborated with" as indefinite and therefore denies this Request for Admission. As explained below, Respondent has disclosed the nature of its past relations with PositiveID Corporation fully.

Request for Admission 25: Admit VCI hosted a joint demonstration with PositiveID Corporation's wireless communication device for diabetes management operating in conjunction with VCI's robotic telepresence.

In response to this Request for Admission, VCI admitted that it drove its robot from its booth to that of PositiveID Corporation but denies this Request for Admission because the Respondent's robotic device did not operate "in conjunction with its [PositiveID's] wireless communications device for diabetes management." In response to Interrogatory No. 16, VCI

stated “PositiveID invited VCI to do a demonstration at the American Telemedicine Conference at PositiveID’s booth at that conference but not in conjunction with PositiveID Corporations’ wireless communications device for diabetes management. For the one-time demonstration, VCI drove its robot from its booth to their booth at the tradeshow. When VCI was at the PostiveID Corporation booth, VCI personnel talked with PositiveID Corporation personnel. VCI did not integrate PositiveID Corporation equipment with VCI equipment or do anything with or in conjunction with PositiveID Corporation equipment.”

As can be seen, Petitioner’s failed attempts to find documents to support its theory that Respondent’s mark and product are used in the treatment, evaluation and/or counseling of patients with diabetes is not because the Respondent has withheld documents or not answered discovery requests completely. There are no such documents because Respondent’s products are communications robots used for video and phone conferencing and not used in treating, evaluating or counseling patients with diabetes. Respondent’s answers are not “non-responsive, vague or ambiguous.” Petitioner does not like the answers provided.

Respondent continues to reiterate that it has supplied all information and documents to respond to Petitioner’s discovery requests and requests for admissions. The Motion to Compel and Reopen Discovery should accordingly be denied.

VGO COMMUNICATIONS, INC.

By its attorneys,

/barbara a. barakat/

Michael J. Bevilacqua
Barbara A. Barakat
Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, Massachusetts 02109
(617) 526-6000

Date: November 25, 2014

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Registrant's Responses to Petitioner's First Set of Interrogatories to Registrant was served by first-class mail, postage-prepaid, this 25th day of November, 2014 upon:

Sheri S. Mason, Esq.
Thomas F. Dunn, Esq.
Morse, Barnes-Brown & Pendleton, P.C.
City Point
230 Third Avenue, Fourth Floor
Waltham, Massachusetts 02451

/barbara a. barakat/

Barbara A. Barakat

EXHIBIT A

Barbara A. Barakat

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November 25, 2014

By Email
Confirmation copy by First Class Mail

Sheri S. Mason, Esq.
Morse Barnes-Brown Pendleton PC
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230 Third Avenue, 4th Floor
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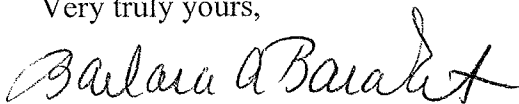
Re: Valeritas, Inc. v. VGO Communications, Inc.
Cancellation No. 92054171

Dear Sheri:

Enclosed with the confirmation copy of this letter are Respondent's Documents Nos. VGO 001509 - 001738. VGo has conducted an exhaustive search but has been unable to locate a copy of two reseller agreements, with RoData and IVCI. If VGo locates a copy of either of those agreements, it will be forwarded to you immediately. You should note, however that the agreements will be substantially similar to the other reseller agreements already provided.

If there are any other questions, do not hesitate to contact us.

Very truly yours,



Barbara A. Barakat

Enclosures (w/ confirmation copy)

cc: Thomas F. Dunn, Esq. (w/o enclosures)
Michael J. Bevilacqua, Esq. (w/o enclosures)